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IN THE

Supreme Court of the United States

OCTOBER TERM 1961

No. [redacted] 138

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,

Petitioner,

—v.—

ALLEN B. DU MONT LABORATORIES, INC.,

Respondent.

RESPONDENT'S SUPPLEMENTAL BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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No. 993

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,

Petitioner,

—v.—

ALLEN B. DU MONT LABORATORIES, INC.,

Respondent.

RESPONDENT'S SUPPLEMENTAL BRIEF IN OPPOSITION TO PETITION

This brief is in opposition to Petitioner's Supplemental Brief. We will show:

1. This Court has denied certiorari where there was a direct conflict between two Circuits as to validity, where the patent had already expired. The patent here expired 7 years ago.

2. That there is no actual conflict of law between the two Circuits, only a conflict of fact.

I.

Certiorari Should Be Denied Since the Patent Expired Seven Years Ago.

The only Pierce patent in question here was granted on October 18, 1938. Therefore, it expired 17 years later[1]

[1] 35 U. S. C. 154 (1958).

on October 18, 1955. This was some six years prior to the decision of the Third Circuit Court of Appeals[2] and some seven years prior to the alleged conflicting decision of the Fifth Circuit Court of Appeals.[3]

Petitioner says that she knows of no prior denial of certiorari where there was "conflict" between two Circuits on validity of a patent. Petitioner overlooked the case of *Frank B. Killiam & Co.* v. *Allied Latex Corp.* in which this Court denied certiorari despite such a conflict.

The facts of the *Killiam* case are strikingly similar to the facts here. There, the patent in question (1,605,445) was issued on November 2, 1926 and it expired on November 2, 1943. The patent was first held *valid* by the Court of Appeals for the Eighth Circuit[4] and later held *invalid* by the Court of Appeals for the Second Circuit[5] 8 years after it expired. Certiorari was denied.[6]

There would be nothing to be gained by the granting of this Petition since there is no public interest remaining to be served in view of the expiration of the patent. Further, there is no question involved which would have any bearing upon future decisions.

For these reasons alone, the Petition should be denied.

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[2] *Pierce* v. *Allen B. Du Mont Laboratories, Inc.*, 297 F. 2d 323 (decided November 29, 1961).

[3] Decided on September 6, 1962. This decision is reprinted in Appendix C of Petitioner's Supplemental Brief.

[4] *Dean Rubber Manufacturing Co.* v. *Killiam*, 106 F. 2d 316 (8th Cir. 1939).

[5] *Frank B. Killiam & Co.* v. *Allied Latex Corp.*, 188 F. 2d 940 (2nd Cir. 1951).

[6] 342 U. S. 861 (1951); 96 L. ed. 648; 72 S. Ct. 86; rehearing denied 342 U. S. 895 (1951); 92 L. ed. 670.

II.

Certiorari Should Be Denied Since There Is No Actual Conflict of Law Between the Circuits—Only of Fact.

In Petitioner's Supplemental Brief, it is asserted that the Petition for Certiorari should now be granted in view of the "direct conflict" that exists between the decisions of the Court of Appeals for the Third Circuit (decided November 29, 1961)[7] and the Court of Appeals for the Fifth Circuit (decided September 6, 1962)[8] on the question of the invalidity for double patenting of Pierce patent 2,133,642 over prior issued Pierce patent 1,789,496. There is no conflict of law between the two Circuits, but only of fact of whether the Patent Office required division.

The holding of double patenting[9] by the Court of Appeals for the Third Circuit is based upon the law stated in *Palmer* v. *Lozier*, 90 Fed. 732 (6th Cir. 1898). The *Palmer* case, which follows *Miller* v. *Eagle Manufacturing Co.* (1894), 151 U. S. 186, 198, clearly holds that a patentee who has made only a single invention cannot extract the essential element which resulted in the granting of a first patent for a combination and make this essential element the subject of a separate and later issued patent. To do so would extend the monopoly of the single invention.

In reaching its holding of double patenting of Pierce patent 2,133,642, the Third Circuit Court of Appeals, and

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[7] *Pierce* v. *Allen B. Du Mont Laboratories, Inc.*, 297 F. 2d 323 (3rd Cir. 1961); affirming 178 F. Supp. 84 (D. Del. 1959), which held Pierce patent 2,133,642 invalid for double patenting over prior issued Pierce patent 1,789,496.

[8] Reprinted in Appendix C of Petitioner's Supplemental Brief. (Citations to Appendix C are designated by p. A.)

[9] 297 F. 2d 323.

the District Court, were confronted with the previous Third Circuit decision in *National Tube Co.* v. *Steel & Tubes, Inc.*, 90 F. 2d 52 (3rd Cir. 1937), which held that where the Patent Office required division of one patent application into several applications, there could be no later holding of double patenting.

After a full trial on the merits, at which Petitioner's counsel (the same attorney who prosecuted the patents in question in the Patent Office) testified, the District Court for the District of Delaware expressly held[10] that there was no requirement for division by the Patent Office;[11] that *National Tube* v. *Steel & Tubes* therefore did not apply; that the doctrine of *Palmer* v. *Lozier* was applicable; and that Pierce patent 2,133,642 was invalid for the double patenting over prior issued Pierce patent 1,789,496. The Third Circuit Court of Appeals expressly affirmed each of these holdings of the District Court, including the holding that there was no requirement for division made by the Patent Office.

The "independent consideration" (p. 11A) and decision by the Fifth Circuit Court of Appeals, holding that there was no double patenting, stands upon an entirely different foundation. There was no contested trial in the District Court and no confrontation of witnesses by the Court.

However, the Court of Appeals for the Fifth Circuit said (p. 3A, footnote 1):

> "We think the record fully supports the statement made by this Court in the previous opinion to the effect

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[10] 178 F. Supp. 84 (D. Del. 1959).

[11] 178 F. Supp. 85, footnote 3, at which the Court states: "I have carefully reviewed the evidence on this point and conclude that there was no formal demand, or requirement, for a division."

that 'it was the Patent Office that required the division that led to the two separate patents.'"

Therefore, after finding that there *was a Patent Office requirement for division*, the Court said (p. 7A) that:

"Since it was the Patent Office which required the division that led to the two separate patents, plaintiff does not come under the rule of Palmer Pneumatic Tire Co. v. Lozier, 6 Cir., 90 Fed. 732, prohibiting one from extracting an essential element of his invention from a former patent without which that patent would not have been granted and taking it for the subject of a new patent."

And again the Court said (p. 9A):

"Moreover, it is clear that the trial court completely ignored that part of our earlier opinion quoted above dealing with the case of Palmer Pneumatic Tire Co. v. Lozier . . ."

Therefore, it is clear that the Fifth Circuit decision does not repudiate *Palmer* v. *Lozier* as the law. Instead, the Court impliedly recognizes *Palmer* v. *Lozier* as still being the law but never reaches the application of its doctrine because of the Court's holding that the Patent Office required division, which resulted in the two patents. Therefore, had it not been for the erroneous finding by the Fifth Circuit Court of Appeals that there was a Patent Office requirement for division, that Court would have been constrained to hold double patenting on the basis of *Palmer* v. *Lozier*.

Petitioner is therefore asking this Court to review only a conflict of fact. It has been a long standing practice of this Court to deny certiorari to review evidence and discuss particular facts, *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U. S. 175, 178 (1937), 82 L. Ed. 1273, and there is no reason for an exception in this case.

Finally, there is no "conflict" between the decision of the Court of Appeals for the Third Circuit in this case and the decision of this Court in *Aro Mfg. Co.* v. *Convertible Top Replacement Co.* (1961), 365 U. S. 336. The *Aro* case concerned the question of contributory infringement, which is entirely separate and distinct from the question of double patenting and the extension of the duration of the patent monopoly presented here.

CONCLUSION

It is accordingly prayed:

1. That the Petition be denied.

2. That if the Petition be granted Du Mont's Question No. 1 be decided first as a preliminary question.

3. That if the Petition should be granted and Du Mont's Question No. 1 be answered in the affirmative and Pierce's

question in the negative, then Du Mont's Questions Nos. 2 to 6 be decided by this Court, or the case remanded with instructions that they be decided by the Courts below.

Respectfully submitted,

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